REMARKS

1. Preliminary Matters

a. Status of the Claims

Claims 1-12 are pending in this application. Applicant respectfully requests entry of the remarks made herein into the file history of the application. Claims 5 and 6 are under active consideration.

2. Patentability Remarks

a. 35 U.S.C. § 103(a)

On pages 3-5 of the Office Action, the Examiner rejects claims 5 and 6 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Publication No. 2003/0207812 to Chapdelaine et al. ("Chapdelaine"). The Examiner alleges that the claims are obvious because one of ordinary skill in the art would have selected a species of the claims and would have reasonably expected similar properties as disclosed by Chapdelaine. Applicant respectfully disagrees.

It is well-settled law that the Patent Office has the initial burden of putting forth a prima facie case for obviousness that must be based on factual evidence. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). The Patent Office Guidelines for Determining Obviousness (06 Nov 2007) instruct Office personnel to include findings of fact about the state of the art and the teachings of the references applied.

> "The key to supporting any rejection under 35 U.S. C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S. C. 103 should be made explicit. . . . Rejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (Guidelines, Section III)

Applicant's claims are directed to a method of treating a patient suffering from damage to normal tissue attributable to heart disease. The Examiner asserts, "it would have been obvious . . . to select any of the species of the genus taught by the reference . . . ." What is conspicuously lacking in the rejection is any comment or statement of fact that bears on the *method* claimed by Applicant and how it would have been obvious over Chapdelaine. The claimed invention as a whole must be the focus in an obviousness analysis and not one or more of the component parts. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995). Chapdelaine does not teach or suggest or provide any other reason to lead a skilled artisan to believe that the disclosed compounds might be used in the method claimed by the Applicant. In fact, the Examiner only states that the compound of Chapdelaine are disclosed as ligands of CD45 which inhibit protein tyrosine phosphatase activity (para 0025). Since CD45 activity is essential for T cell activation Chapdelaine discloses the utility of the compounds for T cell related disorders such as autoimmune disorders and organ graft rejection. The Examiner has failed to explain why a skilled artisan reading Chapdelaine would have had any reason to use the disclosed compounds for PTEN related disorders

including those claimed by the Applicant. As such, Applicant respectfully submits that a *prima facie* case of obviousness over Chapdelaine has not been properly established. In view of the foregoing, Applicant respectfully submits that the rejection of claims 5 and 6 under 35 U.S.C. §103 be reconsidered and withdrawn.

3. Relevant Art of Record

On page 5 of the Office Action, U.S. Patent No. 6,777,439 was made of record but not relied upon by the Examiner. Accordingly, no comment on the statements made by the Examiner with respect to this reference is necessary.

4. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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